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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/811,060	03/15/2001	Arvind Kumar	42390P10464	7288

8791 7590 09/13/2004

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EXAMINER

COURTENAY III, ST JOHN

ART UNIT	PAPER NUMBER
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2126

DATE MAILED: 09/13/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/811,060

Applicant(s)

KUMAR, ARVIND

Examiner

St. John Courtenay III

Art Unit

2126

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 March 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-41 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1,2,5-10,22-27,33-36,40 and 41 is/are allowed.
- 6) ☐ Claim(s) 3,4,11-21,28-32 and 37-39 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.


Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 15 March 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.


ST. JOHN COURTENAY III
PRIMARY EXAMINER

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

Detailed Action

35 U.S.C. 112, second paragraph

Dependent claims 3 & 4 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

"said field identifiers" lacks positive antecedent basis.

Appropriate correction is required.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 11-13, 28-30, 37-39 are rejected under 35 U.S.C. § 102(b) as being anticipated by **Hughes et al.** (U.S. Patent 5,892,908).

As per independent claims 11, 28, 37:

Hughes teaches an apparatus, comprising a readable medium having instructions encoded thereon for execution by a processor, the instructions capable of directing the processor to perform:

- receiving, with the application program, a block of data comprising an electronically distributable document [e.g., see step 202, fig. 10 and associated discussion col. 5, beginning line 1];

- identifying the URL within the block of data [see steps 214 – 218, fig. 10, and associated discussion col. 5];
- adding an entry to a collective, the entry including the URL and origin data corresponding to the URL [see step 222, fig. 10, and associated discussion col. 5; see also updating the database discussion, col. 4, beginning line 20; see “The URL is saved to the retrieval database at step 154” and associated discussion col. 4, beginning line 16];
- retrieving content identified by the URL according to an applicable policy [e.g., see retrieving file associated with the URL and associated discussion col. 5, beginning line 18] ; and
- storing the retrieved content within the collective [see storing on the hard drive 58 of the local machine, col. 2, line 58; see also saving file to the hard drive discussion col. 4, beginning line 19].

As per dependent claims 12, 29 & 38:

Hughes teaches the instructions for the policy for retrieving content comprises instructions for a selected one of: retrieving selected content when the application program operates on the block of data [see fig 8 and the process of extracting network information, and associated discussion col. 4, beginning line 1];

As per dependent claims 13, 30 & 39:

Hughes teaches the instructions further comprising instructions capable of directing the processor to perform:

- preparing a list of the URLs within the block of data [see "The URL is saved to the retrieval database at step 154" and associated discussion col. 4, beginning line 16];
- displaying an interface allowing selection of URL entries of the list [e.g., see user clicking mouse to select hyper text links, and associated discussion col. 3, beginning line 35]; and
- performing the retrieving content for a selected entry of the list [e.g., see retrieving file associated with the URL and associated discussion col. 5, beginning line 18].

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which the subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 14 – 21, 31 & 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Hughes et al.** (U.S. Patent 5,892,908) in view of **Santoro et al.** (U.S. Patent 6,724,403).

As per dependent claims 14-16:

Hughes discloses the invention substantially as claimed, as discussed above.

However, **Hughes** does not *explicitly* teach the following additional limitations:

Santoro teaches where the application program is an Electronic Mail (E-mail) program and the block of data is an E-mail message with definable rules operable on the block of data, and a user-interface configured to display URLs, and allow selection thereof, wherein selection of the URL triggers the retrieving [e.g, see "e-mail messages" col. 4, line 45, and associated "e-mail tile" discussion beginning, col. 15, line 61; see URL pre-fetch manager 2208, col. 19, discussion beginning line 54 and URL manager 2206, col. 19, line 39].

It would have been obvious to one of ordinary skill in the art at the time the invention was made to improve upon the system taught by **Hughes** by implementing the improvements detailed above because it would provide **Hughes's** system with the enhanced capability of interoperability with e-mail applications coupled with an enhanced user interface comprised of view "tiles."

As per dependent claim 17:

This claim is rejected for the same reasons detailed above in the rejection of dependent claim 14, and also for the following additional reasons:

Santoro teaches identifying the URL is performed with a system-wide program module operable on plural concurrently executing application programs [see URL pre-fetch manager 2208, col. 19, discussion beginning line 54 and URL manager 2206, col. 19, line 39].

As per dependent claim 18:

This claim is rejected for the same reasons detailed above in the rejection of dependent claim 14, and also for the following additional reasons:

Santoro teaches the collective comprises a selected one of: Microsoft Internet browser Favorites, and Netscape Internet browser bookmarks [see Internet Explorer, col. 19, line 29 and Netscape Navigator, col. 19, line 30 and surf widget controller 2202, col. 19, line 29].

As per dependent claim 19:

Santoro teaches executing the application program within an operating system providing offline storage for content retrievable over the network and configuring the offline storage to retrieve the content identified by the URL [see URL pre-fetch manager 2208, col. 19, discussion beginning line 54 and URL manager 2206, col. 19, line 39].

As per dependent claims 20-21:

Claims 20 & 21 are rejected for the same reasons detailed above in the rejection of dependent claim 14, and also for the following additional reasons:

Santoro teaches executing the application program within an operating system providing offline storage for content retrievable over the network; and configuring the offline storage so that the content identified by the URL is retrieved in accordance with the policy [see URL pre-fetch manager 2208, col. 19, discussion beginning line 54 and URL manager 2206, col. 19, line 39; see also URL loader that comprises a network proxy for filtering the block of data - col. 20, discussion beginning line 49].

As per dependent claim 31:

This claim is rejected for the same reasons detailed above in the rejection of dependent claim 14, and also for the following additional reasons:

Santoro teaches the instructions further comprising instructions capable of directing the processor to perform:

- executing the application program within an operating system [e.g, see "e-mail messages" col. 4, line 45, and associated "e-mail tile" discussion beginning, col. 15, line 61; see URL pre-fetch manager 2208, col. 19, discussion beginning line 54 and URL manager 2206, col. 19, line 39];
- providing offline storage for content retrievable over the network [see URL pre-fetch manager 2208, col. 19, discussion beginning line 54 and URL manager 2206, col. 19, line 39]; and
- configuring the offline storage to retrieve the content identified by the URL [see URL pre-fetch manager 2208, col. 19, discussion beginning line 54 and URL manager 2206, col. 19, line 39].

As per dependent claim 32:

This claim is rejected for the same reasons detailed above in the rejection of dependent claim 14, and also for the following additional reasons:

Santoro teaches the instructions further comprising instructions capable of directing the processor to perform:

- executing the application program within an operating system providing offline storage for content retrievable over the network [e.g, see "e-mail messages" col. 4, line 45, and associated "e-mail tile" discussion beginning, col. 15, line 61; see URL pre-fetch manager 2208, col. 19, discussion beginning line 54 and URL manager 2206, col. 19, line 39]; and

- configuring the offline storage so that the content identified by the URL is retrieved in accordance with the policy [see URL pre-fetch manager 2208, col. 19, discussion beginning line 54 and URL manager 2206, col. 19, line 39].

Allowable Subject Matter:

Claims 1-10, 22-27, 33-36, 40, 41 appear to be allowable over the prior art of record, subject to the results of a final search.

Note: Dependent claims 3 & 4 stand rejected under 35 U.S.C. § 112, as detailed above. Allowance of claims 3 & 4 is contingent upon correction of the 112 antecedent basis problem, and is also subject to the results of a final search.

The prior art of record does not teach nor fairly suggest executing an **agent** to identify a URL within the block of data and extracting **meta-data** associated with the URL describing the block of data, as claimed.

Prior Art not relied upon:

Please refer to the references listed on the attached PTO-892 which are not relied upon in the claim rejections detailed above.

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How to Contact the Examiner:

Any inquiry concerning this communication or earlier communications from the examiner should be directed to St. John Courtenay III, J.D., M.B.A., whose telephone number is 703-308-5217. This number will change to 571-272-3761 after Oct. 25, 2004. A voice mail service is also available at this number. The Examiner can normally be reached on M - F 7:30 AM - 4:00 PM.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor is An Meng-AI who can be reached on 703-305-9678. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

All responses sent by U.S. Mail should be mailed to:

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PO Box 1450
Alexandria, VA 22313-1450

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Patent Customers advised to FAX communications to the USPTO

<http://www.uspto.gov/web/offices/pac/dapp/opla/preognotice/faxnotice.pdf>

Effective Oct. 15, 2003, ALL patent application correspondence transmitted by FAX must be directed to the new PTO central FAX number:


**NEW PTO CENTRAL FAX NUMBER:
703-872-9306**

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- Any inquiry of a general nature or relating to the status of this application should be directed to the **TC 2100 Group receptionist: (703) 305-3900.**

Please direct inquiries regarding fees, paper matching, and other issues not involving the Examiner to:

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The Manual of Patent Examining Procedure (MPEP) is available online at:
<http://www.uspto.gov/web/offices/pac/mpep/index.html>


**ST. JOHN COURTENAY III
PRIMARY EXAMINER**